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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

204432-0019

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on 1-13-06
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Application Number

09/454,755

Filed

6 DEC 1999

First Named Inventor

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Art Unit

2672

Examiner

YANG, Ryan R.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 39937☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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January 13, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

Applicant believes there is a clear deficiency in the Examiner's prima facie case. The Examiner asserts that the Vyncke reference (U.S. Patent No. 5,926,185) teaches:

the object 210 in Figure 8a is not opaque (column 8, line 37). Since the object is not opaque, it is either semi-transparent or transparent. Therefore, Vyncke still meets the claim limitations.

September 7, 2005 Office Action at p. 13. Not being opaque does not establish that the object is semi-transparent.

In its June 17, 2005 Response at pp. 3-10, Applicant amended its claims to recite "semi-transparent" instead of "translucent" because the Examiner argued that *translucent* meant *transparent*. See April 22, 2005 Office Action at pp. 13-14. Applicant also asserted that the definition of *translucent* (in the April 22, 2005 Office Action) that was more compatible with the specification is: "admitting and diffusing light so that the object beyond cannot be clearly distinguished; partly transparent." June 17, 2005 Response at p. 12. This definition is supported by the specification's repeated references to "transparent *or* translucent." *Id.* (emphasis added).

Despite his apparent acknowledgement that neither Vyncke nor any other cited reference expressly teaches a semi-transparent object, the Examiner continues to assert that Vyncke (1) anticipates claims 1-2, 6-11, 15-18, and 28-30; (2) renders obvious, standing alone, claims 19-20 and 24-27; and (3) renders obvious the remaining dependent claims as obvious in view of

Vyncke in combination with other art.¹ September 7, 2005 Office Action at pp. 2 (anticipation based on Vyncke alone), 9 (obviousness based on Vyncke alone), 11 (obviousness of remaining dependent claims 5, 14, and 23). This is clear error. When Vyncke is read carefully, it is apparent that its concern is with either hidden or visible objects – not partly-seen objects. The quoted section is from a paragraph addressing hidden objects; no reference is made to objects that are partially seen. Lacking a clear teaching that Vyncke discloses a semi-transparent object, it cannot anticipate or render obvious the rejected claims.

The Federal Circuit recently acknowledged that the terms *transparent* and *translucent* (which Applicant submits is synonymous with *semi-transparent*) are distinct. “The definition [of clear] also sets forth an express distinction between transparent and translucent: ‘transparent stresses complete absence of obstruction to vision’ and ‘translucent applies to that which permits passage of light but bars clear and complete vision.’” *Terlep v.*

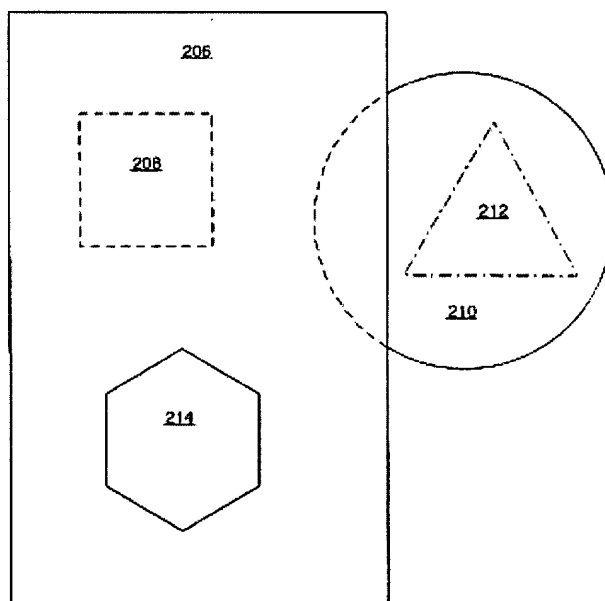


Fig. 8a

Brinkmann Corp., 418 F.3d 1379, 1384 (Fed. Cir. 2005). Vyncke’s Figure 8a (shown above)

¹ Claims 1, 10, 19, 28, 29 and 30 are independent claims. Thus, Vyncke is the sole reference used to reject all independent claims. If Vyncke fails to teach the *semi-transparent* object of the claims, the claims should be allowed.

does not bar clear and complete vision, but instead shows no obstruction to vision. Vyncke's reference to the circle 210 being "not opaque (solid)" is by no means a teaching that the circle is semi-transparent. Vyncke does not anticipate or render obvious the claims.

To anticipate, the prior art must show each and every element of the claim, either expressly or inherently. MPEP 2131 (citing *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631). Vyncke does not expressly disclose that the nature of the object, only that it is "not opaque." "A claim limitation is inherent in the prior art if it is *necessarily* present in the prior art, *not* merely probably or possibly present." *Akamai Techs., Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003). Elsewhere, Vyncke refers to objects as "all opaque (solid) or all transparent," col. 9, line 42-43, indicating that Vyncke did not contemplate a semi-transparent object. Here, the Examiner has not identified any reason to believe that the object 210 in Vyncke is necessarily translucent, i.e., semi-transparent, and it was clear error for him to have rejected the claims.

Respectfully submitted,



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